

REMARKS/ARGUMENTS

Claims 61-64, 67, 68, 70-84, 86-91, and 93-99 are pending in the application. Independent claims 61, 78, and 90 have been amended to recite that the at least one breakable capsule is affixed in the cavity by friction between the capsule and the walls of the cavity defined by the filter element. The amendment to claim 90 necessitated cancellation of claim 92 and a change in dependency for claims 93 and 95. Support for the amendments can be found throughout the specification, such as in paragraph 59 of the application, which discusses forming a friction fit between the capsule and walls of the cavity. Applicants respectfully submit that no new matter is introduced by these amendments.

Claims 61-64, 67, 68, 70-84, and 86-99 stand rejected under 35 U.S.C. §103(a) as unpatentable over the combination of Berger (US 4,046,063), Dorsey (US 5,549,124), Homburger (US 3,297,038), and Irby, Jr. et al. (US 3,390,686). The Examiner relies upon the Dorsey and Homburger references as motivating the inclusion of a breakable capsule in the filter configuration of Berger. Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness, according to a test predominately used by the courts, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim elements. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

With regard to the Supreme Court's decision in *KSR Int'l. Co. v. Teleflex, Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007), it is noted that the Court did not dismiss the usefulness the well-established "teaching, suggestion, or motivation" test set forth above, but merely cautioned against its rigid application. The Supreme Court in *KSR* commented that the Federal Circuit "no doubt has applied the test in accord with these principles [set forth in *KSR*] in many cases." *Id.* at

____, 82 USPQ2d at 1396. However, the Supreme Court also opined that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. . .” *Id.* at ____, 82 USPQ2d at 1395-96. Regardless of the precise test used, the Court, quoting *In re Kahn*, cautioned that “ ‘[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’ ” *Id.* at ____, 82 USPQ2d at 1396.

Applicants respectfully submit that the cited art fails to teach or suggest the claims as originally presented prior to this amendment. However, in order to expedite prosecution, Applicants have modified the claims to clarify preferred aspects of the interaction between the breakable capsule and the walls of the cavity containing the capsule. Specifically, all claims now recite that the at least one breakable capsule is affixed by friction between the capsule and the walls of the cavity (or in the case of claim 90, between the capsule and the inner portion of filter tow material). Nowhere does the cited art teach or suggest such an arrangement. In particular, none of the references cited by the Examiner as suggesting breakable capsules describe the use of frictional contact between a capsule and the walls of a cavity to retain the capsule in a fixed position. The Examiner appears to recognize this deficiency in the art, as the Examiner opined in the related continuation application (Appl. Serial No. 11/503,219) that the same art cited herein with respect to capsules in filters (e.g., Dorsey, Irby, Jr. and Homburger) do not suggest a method where the capsule is affixed in a cavity by friction between the capsule and the filter material defining the cavity. Accordingly, for at least this reason, Applicants respectfully request reconsideration and withdrawal of this rejection.

In addition, all claims of record recite that the payload of the capsules is an anhydrous liquid or gel comprising a flavoring agent and a diluting agent. This is clearly not taught in any of the cited references relied upon by the Examiner as suggesting capsules within a filter. The Homburger patent relates to capsules containing a granular material such as activated charcoal. There is no suggestion in Homburger to fill a capsule with a liquid or gel composition as presently claimed. In addition, the Dorsey patent fails to teach or suggest an anhydrous liquid or

gel composition within a filter. Instead, the Dorsey patent repeatedly refers to the capsule as containing water. See title, abstract, and both paragraphs in column 1.

It is also noted that there would be no motivation to alter the contents of the capsules of Homburger or Dorsey in order to arrive at the claimed invention, because to do so would clearly render the capsules unsuitable for their intended purpose. The purpose of the Homburger capsule is to expose smoke to a granular activated carbon material. The purpose of the Dorsey capsule is to wet tobacco with water. Both of these purposes would be frustrated by use of an internal payload in the form of an anhydrous liquid or gel.

It is also noted that the cited Irby, Jr. patent fails to teach or suggest a capsule comprising the claimed internal payload and also fails to teach or suggest use of such a capsule within a cavity as presently claimed. There is nothing in the Irby, Jr. patent suggesting the use of an anhydrous liquid or gel composition within a capsule that comprises both a flavoring agent and a diluting agent that is not water. Instead, Irby, Jr. focuses on the use of water as the treating liquid and also teaches payload embodiments comprising solid adsorbents in slurry form. The Irby, Jr. reference professes a clear intent to “moisturize” activated carbon with the liquid in the capsules so that smoke pulled through the filter can interact with the moisturized carbon particles. The Irby, Jr. reference does not suggest any embodiments combining a flavoring agent with a diluting agent in an anhydrous liquid or gel. There would be no reasonable expectation of success when using such a capsule payload as the Irby, Jr. reference clearly fails to suggest that such a payload would achieve the desired moisturizing effect. Only impermissible hindsight based on the present application would lead one to combine the teachings of Irby, Jr. with the Mane capsules referenced in the present application and noted by the Examiner.

Applicants specifically traverse the suggestion by the Examiner that the Mane capsules noted in the present application would be viewed as obvious replacements for the capsules of Homburger and Dorsey. As noted above, the purpose of the Homburger capsule is to expose smoke to a granular activated carbon material and the purpose of the Dorsey capsule is to wet tobacco with water. One of ordinary skill in the art would not replace the capsules of Homburger or Dorsey with Mane capsules containing no water and no carbon material. Nothing in Homburger or Dorsey would suggest that such capsules would be suitable for the purposes set

Appl. No.: 10/600,712
Amdt. dated May 20, 2010
Reply to Office Action of January 21, 2010

forth therein. For at least these additional reasons, Applicants again respectfully request reconsideration and withdrawal of the rejection.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 09-0528.

Respectfully submitted,

/christopher m. humphrey/

Christopher M. Humphrey
Registration No. 43,683

Womble Carlyle Sandridge & Rice, PLLC
Customer No.: 26158
Attn: Patent Docketing
P O Box 7037
Atlanta, GA 30357-0037
Tel: Raleigh Office (919) 755-8151
Fax: Raleigh Office (919) 755-2150

ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON MAY 20, 2010.